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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

FEY ET AL.

CASE NO: FA1097 US NA

SERIAL NO: 10/611,731

GROUP ART UNIT: 1762

FILED: JULY 1, 2003

EXAMINER: E. CAMERON

FOR: PROCESS FOR THE PRODUCTION  
OF PAINT COATING LAYERS

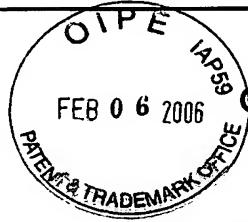
APPEAL BRIEF

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Pursuant to 37 C.F.R. § 1.192, the following is an Appeal Brief in support of the Appeal filed November 29, 2005, appealing the Final Office Action dated September 13, 2005. Submitted herewith is the filing fee for this Appeal Brief in accordance with 37 C.F.R. § 41.20(b)(2). Please charge said fee to Deposit Account No. 04-1298 (E.I. du Pont de Nemours and Company).

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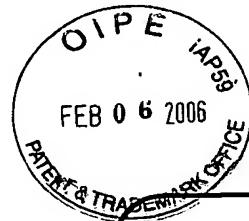
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Application No: 10/611,731  
Filing Date: July 1, 2003  
First Named Inventor: Thomas Fey  
Title: Process for the Production of Paint Coating Layers  
Attorney Docket: FA1097 US NA

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## TRANSMITTAL FORM

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<b>TRANSMITTAL FORM</b> <i>(to be used for all correspondence after initial filing)</i>		Application Number	10/611,731
		Filing Date	July 1, 2003
		First Named Inventor	Thomas Fey
		Group Art Unit	1762
		Examiner Name	Erma C. Cameron
Total Number of Pages in This Submission	18	Attorney Docket Number	FA1097 US NA

### ENCLOSURES (check all that apply)

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### SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Hilmar L. Fricke, Registration No. 22,384
Signature	
Date	February 1, 2006

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# FEE TRANSMITTAL for FY 2005

Patent fees are subject to annual revision.

 Applicant Claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT** (\$ 500.00)**Complete if Known**

Application Number	10/611,731
Filing Date	July 1, 2003
First Named Inventor	Thomas Fey
Examiner Name	1762

Group / Art Unit Erma C. Cameron

Attorney Docket No. FA1097 US NA

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E.I. Dupont de Nemours and Company

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**FEE CALCULATION****1. BASIC FILING FEE**

Large Entity | Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
101	1000	201	500	Utility filing fee	
106	430	206	215	Design filing fee	
107	660	207	330	Plant filing fee	
108	1400	208	700	Reissue filing fee	
114	200	214	100	Provisional filing fee	

SUBTOTAL (1) (\$)

**2. EXTRA CLAIM FEES**

Total Claims	-20	=	0	X	50	=	0
Independent Claims	-3	=	0	X	200	=	0
Multiple Dependent	<input type="checkbox"/>			X	360		

Large Entity | Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description
103	50	203	25	Claims in excess of 20
102	200	202	100	Independent claims in excess of 3
104	360	204	180	Multiple dependent claim, if not paid
109	200	209	100	** Reissue independent claims over original patent
110	50	210	25	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$ 0)

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**FEE CALCULATION (continued)****3. ADDITIONAL FEES**

Large Entity | Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
105	130	205	65	Surcharge - late filing fee or oath	
127	50	227	25	Surcharge - late provisional filing fee or cover sheet	
139	130	139	130	Non-English specification	
147	2,520	147	2,520	For filing a request for reexamination	
112	920*	112	920*	Requesting publication of SIR prior to Examiner action	
113	1,840*	113	1,840*	Requesting publication of SIR after Examiner action	
115	120	215	60	Extension for reply within first month	
116	450	216	225	Extension for reply within second month	
117	1020	217	510	Extension for reply within third month	
118	1,590	218	795	Extension for reply within fourth month	
128	2,160	228	1,080	Extension for reply within fifth month	
119	500	219	250	Notice of Appeal	
120	500	220	250	Filing a brief in support of an appeal	500.00
121	1000	221	500	Request for oral hearing	
138	1,510	138	1,510	Petition to institute a public use proceeding	
140	500	240	250	Petition to revive – unavoidable	
141	1,500	241	750	Petition to revive – unintentional	
142	1,400	242	700	Utility issue fee (or reissue)	
143	800	243	400	Design issue fee	
144	100	244	550	Plant issue fee	
122	130	122	130	Petitions to the Commissioner	
123	50	123	50	Processing fee under 37 CFR 1.17(q)	
126	180	126	180	Submission of Information Disclosure Stmt	
581	40	581	40	Recording each patent assignment per property (times number of properties)	
146	790	246	395	Filing a submission after final rejection (37 CFR § 1.129(a))	
149	790	249	395	For each additional invention to be examined (37 CFR § 1.129(b))	
179	790	279	395	Request for Continued Examination (RCE)	
169	900	169	900	Request for expedited examination of a design application	

Other fee (specify) \_\_\_\_\_

\*Reduced by Basic Filing Fee Paid

SUBTOTAL (3)

(\$ 500.00)

**SUBMITTED BY**

Complete (if applicable)

Name (Print/Type)	Hilmar L. Fricke	Registration No. Attorney/Agent)	22,384	Telephone	(302) 984-6058
Signature					Date February 1, 2006

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**I. REAL PARTY IN INTEREST**

The real party in interest is E.I. du Pont de Nemours and Company (*hereinafter* “DuPont”), owner of the Application.

**II. RELATED APPEALS AND INTERFERENCES**

There are no other appeals or interferences known to Applicants, Applicants' legal representative, or DuPont that will directly affect or be directly affected by or have a bearing on the Board of Patent Appeals and Interferences' (*hereinafter* the “Board”) decision in the present Appeal.

**III. STATUS OF THE CLAIMS**

Claims 1-6, 8-10, and 12-13 stand rejected and are the subject of this Appeal. Originally-filed claims 7 and 11 and later-filed claims 14-41 have been canceled.

**IV. STATUS OF AMENDMENTS**

No amendments were made to the claims in response to the Final Office Action.

**V. SUMMARY OF CLAIMED SUBJECT MATTER**

Claim 1, the only independent claim at issue, relates to a process for the production of a coating layer from a thermally curable coating composition on a substrate (see page 1, lines 10-12), consisting of the successive steps of a) providing a substrate to be coated (see page 3, lines 28-29), wherein the substrate is selected from the group consisting of automotive bodies, body parts and body fittings (see page 4, lines 5-8); b) applying a coated backing foil consisting of a foil coated on one side with an uncured or at least only partially cured coating layer of a thermally curable coating composition, with its coated side on the entire surface or on at least one sub-zone of the surface of the substrate (see page 4, line 30 – page 5, line 2), c) supplying energy consisting of thermal energy onto the entire coating applied in step b) thereby curing the coating (see page 14, lines 13-17), and d) removing the backing foil from the coating which remains on the substrate (see page 16, lines 3-5).

**VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

Whether claims 1-6, 8-10, and 12-13 are unpatentable under 35 U.S.C. § 112, 1<sup>st</sup> paragraph, for failing to comply with the written description requirement.

Whether claims 1-2, 5-6, 8-10, and 12-13 are anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 4,061,516 (*hereinafter* "George *et al.*").

Whether claims 1-3, 5, 8-10, and 12-13 are anticipated under 35 U.S.C. § 102(b) by WO 95/02461 (*hereinafter* "Miller").

Whether claims 3 and 4 are obvious under 35 U.S.C. § 103(a) in view of George *et al.*.

Whether claim 4 is obvious under 35 U.S.C. § 103(a) in view of Miller.

**VII. GROUPING OF CLAIMS**

Applicants affirm that all of claims 1-6, 8-10, and 12-13 are to stand or fall together.

**VIII. ARGUMENT**

**A. The Final Office Action**

**1. Rejections Under 35 U.S.C. § 112, 1<sup>st</sup> Paragraph**

Claims 1-6, 8-10, and 12-13 were rejected under 35 U.S.C. § 112, 1<sup>st</sup> paragraph, as failing to comply with the written description requirement. In responding to the Supplemental Non-Final Office Action dated June 9, 2005, Applicants amended claim 1 to limit the claimed process from one "comprising the following successive steps" to one "consisting of the following successive steps". In the Final Office Action, the Examiner rejected claim 1 and all of the dependent claims on the grounds that, because the specification as originally filed at page 2, lines 30-31, states that the process is one "comprising the following successive steps", an amendment to "consisting of the following successive steps" is narrower than the originally filed specification. The Examiner concluded that such an amendment was new matter.

## **2. Rejections Under 35 U.S.C. § 102(b)**

Claims 1-2, 5-6, 8-10, and 12-13 were rejected under 35 U.S.C. § 102(b) as being anticipated by George *et al.* The Examiner asserted that George *et al.* "teaches applying a design, thermoplastic base coat (an acrylic) and an adhesive (another acrylic) to a carrier sheet such as Mylar, and adhering the coating material to a substrate thru heat and pressure from a roller (i.e. contact heating), after which the Mylar sheet is stripped off. . . ." The Examiner also asserted that George *et al.* "does not state that the coating materials are cured before application to the substrate, therefore they are expected to be uncured, as well as in a tacky state", that the "acrylic adhesive is a clear layer that would have the effect of sealing the base coat and design", and that the "acrylics are olefinic double bonded materials that cure with free-radicals". Further, the Examiner argued that the substrate of George *et al.* could be an automotive part or fitting and that "the partially cured tacky layer of step b) [of claim 1] could be considered to have adhesive properties."

Claims 1-3, 5, 8-10, and 12-13 were rejected under 35 U.S.C. § 102(b) as being anticipated by Miller. The Examiner asserted that Miller

teaches applying metal particles, as well as a varnish such as polyurethane, to a transfer agent (plastic film). The transfer agent and a substrate are then brought [sic] together, before the varnish has had a chance to cure, and then the varnish is cured with heat or radiation. Then the substrate and transfer agent are separated. There would inherently be pressure when the transfer agent and substrate are brought together. . . .

The Examiner also asserted that the substrate of Miller can be an automotive part or fitting, that Applicants' claim 3 is met because the "varnish may be applied to the substrate as well", and that Applicants' claims do not preclude the presence of metal.

## **3. Rejections Under 35 U.S.C. § 103(a)**

Claims 3 and 4 were rejected under 35 U.S.C. § 103(a) as being obvious over George *et al.* The Examiner asserted that George *et al.* "does not teach that the substrate is precoated, or that the foil is textured, but these are obvious variations in the process."

Claim 4 was rejected under 35 U.S.C. § 103(a) as being obvious over Miller. The Examiner asserted that Miller “does not teach that the foil is textured, but this is an obvious design variation in the process.”

### **B. The Advisory Action**

In the Advisory Action mailed on November 23, 2005, the Examiner maintained all of the rejections from the Final Office Action. Specifically, the Examiner reiterated her position that “an amendment from ‘comprising’ to ‘consisting of’ is new matter” and, even if such amendment were allowed, that such an amendment “would require further consideration and/or a new search.” Further, the Examiner noted that she did not assert in the Final Office Action that “the transitional phrase ‘comprising’ must always contain more than claimed.”<sup>1</sup>

### **C. Applicants’ Traversal of the Final Office Action and Arguments in Support Thereof**

#### **1. The New Matter Rejection Was Improper.**

The Examiner asserted that the amending of the word “comprising” to “consisting of” in claim 1 constituted new matter.<sup>2</sup> The Examiner, however, provided no citations of caselaw or from the MPEP for this novel proposition. Applicants only find support for the principle that the term “comprising” *may* contain additional elements not specifically listed in the claim, not that “comprising” must contain additional elements. See, e.g., *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501 (Fed. Cir. 1997) (“‘Comprising’ is a term of art used in claim language which means that the named elements are essential, but other elements *may* be added and still form a construct within the scope of the claim.”) (emphasis added). Indeed,

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<sup>1</sup> Applicants apologize for the what the Examiner took as apparent suggestion by Applicants that the Examiner asserted that comprising must always contain more than claimed. Applicants recognize that the Examiner made no such express assertion, and no confusion related thereto was intended. Applicants were merely trying to make a comparison between the Examiner’s actual rejection, that is, rejecting a claim as containing new matter for amendment from “comprising” to “consisting of”, to the effect of disallowing patent applicants to limit claim scope only to the actual limitations in a claim.

<sup>2</sup> Applicants believe that the rejection should be characterized as a written description rejection, not a new matter rejection. See, e.g., *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319 (Fed. Cir. 2003) (noting that claims should be rejected under section 112, 1<sup>st</sup> paragraph, for lacking adequate written description, not for new matter). Consequently, a written description analysis should apply here.

Applicants have found no case stating that “comprising” *must* be construed to be open-ended.

Patent applicants use the word “comprising” under the assumption that an amendment to “consisting essentially of” or “consisting of” might be required to gain allowance of a claim. Indeed, in *In re Muench*, the Board recognized that

[i]t is well settled that the terms ‘comprising’ and ‘containing’ do not exclude the presence of other ingredients than the one or ones recited, and that a claim reciting those ingredients can properly be rejected on a reference disclosing them and additional ingredients. It is also known that an applicant seeking to restrict his claims may use the very limiting term ‘consisting of’ or the terms of intermediate scope, ‘comprising essentially’, or ‘consisting essentially of’.

79 U.S.P.Q. (BNA) 92, 93 (B.P.A.I. 1948) (internal citations omitted). Patent examiners also have utilized the narrower transition phrases when proposing amendments to gain allowance of claims. See, e.g., *Momentus Golf, Inc. v. Swingrite Golf Corp.*, 312 F. Supp. 2d. 1134, 1140 (S.D. Iowa 2004) (noting that the examiner’s suggested amendments replaced the transition term “comprising” with “consisting essentially of” to avoid anticipatory prior art). Here, the Examiner’s rejection of Applicants’ claims using this novel new matter rejection is an apparent change in USPTO policy contrary to years of established practice. Applicants had no notice of such a change in USPTO policy and, furthermore, do not believe that such a change can be implemented without notice thereof.

While Applicants understand that the USPTO is not involved in infringement actions, an illustration utilizing infringement reveals the unreasonableness of this rejection. Consider an accused process that consists only of the steps enumerated in claim 1. Under the Examiner’s analysis, this accused process would *not* infringe claim 1 with “comprising” as the transitional phrase because the accused process does not contain additional elements. This cannot be correct. An accused process that reads exactly on the claim limitations is the essence of literal infringement. Any other result eviscerates the function of the claims, that is, as a measure of the metes and bounds of a patentee’s right to exclude.

Applicants respectfully submit that the proper inquiry under a written description analysis is whether one of ordinary skill in the art would recognize that the applicant possessed the invention at the time the patent application was filed.

MPEP § 2163.02. There can be no dispute here that one of ordinary skill in the art would recognize that Applicants possessed the present claim 1 invention in light of the disclosure of the invention using “comprising” as a transition phrase and the disclosure of a working embodiment that contains all of the current claim limitations. *Cf. In re Smythe*, 480 F.2d 1376, 1384 (C.C.P.A. 1973) (“The alternative [of unnecessary disclosure] places . . . the undue burden of listing, in the case of applicants, reading and examining, in the case of the Patent Office, and printing and storing, in the case of the public, descriptions of the very many structural and functional equivalents of disclosed elements or steps which are already stored in the minds of those skilled in the arts.”). Consequently, Applicants respectfully submit that the section 112, 1<sup>st</sup> paragraph, rejection is improper and should be withdrawn.

**2. Claims 1-2, 5-6, 8-10, and 12-13 are Novel Over George et al.**

The Examiner’s anticipation rejections rely on the new matter rejection traversed above, namely, that George et al. anticipates claims 1-2, 5-6, 8-10, and 12-13 when claim 1 has “comprising” as a transition phrase.

To begin with, George et al. is directed to repairing defects in a wood grain design printed on the surface of a furniture component (see Summary of the Invention of George et al.). In contrast, Applicants’ process is directed to applying a coating to automotive substrates as set forth in step 1a of Applicants’ claim 1.

George et al. cannot anticipate Applicants’ process because George et al. requires the presence of an adhesive layer in the repair multi-layered composition which Applicants do not use. Further, claim 1 does not cover such an adhesive layer. The coated backing foil that Applicants apply as set forth in claim 1 is defined as “consisting of a foil coated on one side with an uncured or at least only partially cured coating layer of a thermally curable coating composition”. There is no adhesive layer as required by George et al. and, hence, George et al. cannot anticipate Applicants’ invention.

Table 1 exhibits the difference between George et al. and Applicants’ claim 1 invention:

Table 1

George et al. Sheet	Applicants' Claim 1 Invention
Mylar® Backing Sheet	Backing Foil
Printed Design	Thermally Curable Coating Composition
Adhesive Layer	

In George et al., the adhesive layer is applied to substrate under heat and pressure. In Applicants' claim 1 invention, the thermally curable coating composition is applied to the substrate and then thermal energy is applied to cure the composition. There is no adhesive layer.

If the Examiner's position is that the thermally curable coating is an adhesive layer, which it is not, then there is no layer of a Printed Design, which is required by George et al. In either case, George et al. cannot anticipate Applicants' claim 1 invention. Further, it would not be obvious to one skilled in the art in view of the teachings of George et al. to eliminate the adhesive layer since it is a necessary component of the George et al. invention to adhere the design to the substrate.

Because claims 2, 5-6, 8-10, and 12-13 are dependent claims, which recite even further limitations to the claim that has already been traversed, Applicants rely upon the arguments presented above in rebuttal to the Examiner's assertion that claims 2, 5-6, 8-10, and 12-13 are anticipated by George et al.

### **3. Claims 1-3, 5, 8-10, and 12-13 are Novel over Miller**

The Examiner's anticipation rejections rely on the new matter rejection traversed above, namely, that Miller anticipates claims 1-3, 5, 8-10, and 12-13 when claim 1 has "comprising" as a transition phrase.

Miller is directed to a process for the partial metallization of a substrate wherein an extremely thin layer of metallic particles are deposited on a transfer agent (plastic film) and then a varnish layer is applied to the transfer agent or substrate or both in discrete strips and the transfer agent and the substrate are laminated together and the varnish is cured. The metallic particles become absorbed or embedded into the varnish coat which bonds the particles to the substrate thereby providing discrete metal strips. That clearly is not Applicants'

invention as set forth in the claims. Applicants do not apply a metallic coating or strips of a metallic coating to a substrate.

Applicants' claim 1 clearly states that a backing foil "consisting of a foil coated on one side with a uncured or partially cured coating layer of a thermally curable coating composition, with its coated side is applied on the entire surface or on at least one sub-zone of the surface of the substrate". There is no metallic layer or coating. The claims do not embrace or cover a metallic layer or coating of metallic particles. Thus, Miller does not anticipate claim 1.

The Examiner contended that Applicants' claim 3 is met because Miller applies varnish to the substrate; however, none of Applicants' claims embrace applying a metallic layer as required by Miller. The whole concept of Miller is the application of a metallic layer to a substrate by embedding metallic particles in a varnish which is simply not done in Applicants' process.

Because claims 2, 5, 8-10, and 12-13 are dependent claims, which recite even further limitations to the claims that have already been traversed, Applicants rely upon the arguments presented above in rebuttal to the Examiner's assertion that claims 2, 5, 8-10, and 12-13 are anticipated by Miller.

#### **4. Claims 3 and 4 are Nonobvious Over George et al.**

The Examiner's obviousness rejections rely on the new matter rejection traversed above, namely, that claims 3 and 4 are obvious over *George et al.* when claim 1 has "comprising" as a transition phrase.

The same arguments apply here as found in Section VIII(C)(2), *supra*, because there is no adhesive layer that is used by Applicants. Simply precoating the substrate as provided in Applicants' claim 3 does not change the basic problems as pointed out in Section VIII(C)(2), *supra*, with *George et al.* The precoating is not what would normally be considered an adhesive layer as taught by *George et al.* Also, there is no suggestion or teaching in *George et al.* that the backing foil can be textured as is set forth in claim 4. Thus, these rejections are simply unsupported allegations by the Examiner that textured backing foils are an obvious variant in a process such as Applicants.

**5. Claim 4 is Nonobvious Over Miller.**

The Examiner's obviousness rejections rely on the new matter rejection traversed above, namely, that claim 4 is obvious over Miller when claim 1 has "comprising" as a transition phrase. This rejection also is an unsupported allegation by the Examiner and is not taught or suggested in Miller and should be withdrawn.

**IX. CONCLUSION**

For the reasons set forth above, the Board is respectfully requested to reverse the final rejection of pending claims 1-6, 8-10, and 12-13 and indicate allowability of all claims.

Please charge any fee due which is not accounted for to Deposit Account No. 04-1928 (E.I. du Pont de Nemours and Company).

Respectfully submitted,

By: 

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Dated: February 1, 2006

**CLAIMS APPENDIX**

1. A process for the production of a coating layer from a thermally curable coating composition on a substrate, consisting of the successive steps:
  - a) providing a substrate to be coated, wherein the substrate is selected from the group consisting of automotive bodies, body parts and body fittings;
  - b) applying a coated backing foil consisting of a foil coated on one side with an uncured or at least only partially cured coating layer of a thermally curable coating composition, with its coated side on the entire surface or on at least one sub-zone of the surface of the substrate,
  - c) supplying energy consisting of thermal energy onto the entire coating applied in step b) thereby curing the coating, and
  - d) removing the backing foil from the coating which remains on the substrate.
2. The process of claim 1, wherein the supply of thermal energy onto the coating proceeds at least partially through the backing foil.
3. The process of claim 1, wherein the substrate to be coated is provided with a precoat comprising at least one layer.
4. The process of claim 1, wherein the surface of the backing foil in adherence with the coating is textured.
5. The process of claim 1, wherein the uncured or at least only partially cured coating layer in step b) is a coating layer with a tacky surface.
6. The process of claim 1, wherein the thermally curable coating composition applied in step b) contains at least one binder with free-radically polymerizable olefinic double bonds.
8. The process of claim 1, wherein the coated backing foil is applied in step b) with pressure.

9. The process of claim 1, wherein the coated backing foil is applied in step b) with pressure and heat.
10. The process of claim 1, wherein the supply of thermal energy proceeds in step c) by using a method selected from the group consisting of radiant heating, convection, induction heating, contact heating and any combination thereof.
12. The process of claim 1, wherein the coating composition applied in step b) comprises a transparent sealing coating composition.
13. The process of claim 12, wherein the transparent sealing coating composition is applied only onto at least one sub-zone of the surface of the substrate.

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**EVIDENCE APPENDIX**

None

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**RELATED PROCEEDINGS APPENDIX**

None